

REMARKS

Upon entry of the present amendment, claims 1-17 and 18 are pending in the application.

Claim 1 has been amended in an effort to better define the claimed invention. New claim 18 is also intended to better define Applicants' intended invention. Support for the amendments may be found at least in paragraphs [0019]-[0029] as well as in the working examples on pages 10-11, including but not limited to paragraph [0055]. Claim 16 has been amended to correct certain typographical errors. No new matter has been introduced by these amendments.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the following remarks.

1. **Rejection of claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,284,037 to Sapper, hereafter "Sapper", in view of CA 2,154,818 to Bergfried et al., hereafter "Bergfried".**

As a preliminary matter, Applicants note that several different inventions are present in the pending claims. For example, claims 1-11 and 18 are directed to an aqueous pigment paste. In contrast, claims 12-14 disclose an aqueous coating material comprising the aqueous pigment paste of claim 1. Claims 15-17 encompass a process for

making an aqueous coating material by using the pigment paste of claim 1. Thus Applicants have three separate and distinct inventions, a pigment paste, a coating material, and a process of making the second with the first.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Applicants respectfully submit that each of the three presently claimed inventions are patentable over the combination of Sapper and Bergfried, at least because such combination does not meet the above standard with regard to any of claims 1 or 18; 12; or 15.

Sapper's disclosures are limited to a particular additive composition that is used to provide improved stability of aqueous metallic coating compositions. As illustrated in Sapper's working examples, only very low amounts of metallic pigments are used in aqueous paint or coating compositions. For example, Sapper uses 0.2 of aluminum pigment in Paint 1 and 3 of mica pigment in Paint 2 in conjunction with color imparting pigments such as carbon black and blue pigment. Thus, Sapper is absolutely silent as to pigment paste technology, the problems attendant to such pastes, or any solutions thereto. That is, Sapper's teachings relate solely to aqueous metallic coating compositions. The PTO is respectfully requested to provide any clarification as to how Sapper provides any teachings as to the use of his disclosed additive in pigment pastes, if such have been overlooked by the Undersigned.

Although 'stability' can be a factor in both pigment pastes and finished coating compositions, the stability issue is measured/defined differently in each and has different causes. For example, Sapper refers to viscosity changes after 80 days and processing

properties. In contrast, settling and watery phase formation after 6 months, and ideally 1 year, are the focus for the stability of Applicants' pigment pastes. The stability of Bergfried's pigment pastes are measured differently from traditional pigment pastes as they are a special subset of electrically conductive pigments that much carry a charge in the final application. As such, their 'stability' is measured in a 1 to 20 dilution in deionized water. (*See '818, page 6, lines 26-28.*) Thus, those of skill in the art appreciate that 'stability' is a relative term that must be considered in the context of the particular composition in question.

Those of skill in the art understand that while shelf life and stability are a necessary concern in paint and coating compositions, such problems as settling and reduced shelf life are greatly exacerbated with regard to pigment pastes. Pigment pastes are not paint or coating compositions. They cannot be applied to a surface and cured to provide a desirable surface film or finish, in terms of either appearance or performance. Thus, while coating and pigment pastes may share certain raw material components, they are **NOT** equivalent or even similar in terms of either composition or performance. In fact, 'performance' of a pigment paste refers to the stability of the pigment paste while stored and its ability to impart as much color or effect to a 'complete' paint or coating in as small an amount as possible. In contrast, 'performance' of a automotive paint or coating composition generally to the appearance and protective characteristics of the finished film that results after application and cure of the paint or coating in question.

Indeed, the purpose of a pigment paste is to facilitate the storekeeping of pigments and make it as easy as possible to use the pigments in the manufacture of a 'finished' or 'complete' paint or coating composition. Those of skill in the art appreciate that pigments in their raw state can pose safety, health, stability, and/or use issues. However, the desire to obtain pigment pastes with a maximum concentration of pigment must often be balanced by stability concerns. As noted by Applicants' Specification, a pigment paste with poor stability produces a paint or coating with poor quality. (*See Applicants' Specification, paragraph [0005].*)

Finally, those of skill in the art recognize that concentration of pigment is a critical factor that can help or hinder a desired end goal. For example, a 'finished' coating will often require a lower pigment concentration because there is a critical pigment volume concentration (PVC) that can affect the performance properties of the crosslinked film matrix. Thus, one of skill in the art recognizes that high pigment concentrations such as those contemplated in pigment pastes are simply unworkable in reality and immediately discounted with regard to automotive basecoat compositions. Similarly, the high concentrations of pigments in pigment pastes are often attributed to be the cause of settling and watery phase formation.

Taken as a whole, Applicants' and Bergfried's specifications are replete with the unique problems attendant to pigment pastes or pigment concentrates as they termed in Bergfried.

Accordingly, Applicants respectfully submit that the cited combination fails to provide a prima facie case for several reasons.

First, the combination does not suggest Applicants' particular range of at least one mica pigment. The PTO states that "it is considered that the amount of pigment is determined by the desired metallic effect and would have been obvious to one of ordinary skill in the art to utilize a suitable amount of mica in a pigment paste in order to get the desired metallic effect in a final coating comprising the pigment paste. It is the examiner's position that the amount of mica is a result effective variable because changing them it clearly affect the type of product obtained" (*Advisory Action of July 7, 2008, page 2.*)

The Undersigned must respectfully request clarification. What 'result or effect' is the examiner referring to? What 'variable' is the examiner referring to? What 'type of product obtained' is the examiner referring to?

As noted above, the goals of a metallic pigment paste are fundamentally different from the goal of using a metallic pigment in final coating. It is respectfully submitted that those of skill in the art have long been attempting to do what the PTO has so

blissfully suggested, i.e., “to utilize a suitable amount of mica in a pigment paste in order to get the desired metallic effect in a final coating comprising the pigment paste”. Unfortunately, as clearly taught by Applicants’ overall Specification, obtaining a stable mica pigment paste at the desired concentration has been a long sought challenge.

Nor does Bergfried provide any motivation with regard to the mica concentration limitations of Applicants’ claims 1 and 18. Mica pigments have fundamentally different chemistry and dispersion issues as compared to electrically conductive fluorine doped tin oxides used in Bergfried. The PTO has failed to provide any common sense rationale as to how the resultant technical gap can be bridged to provide any motivation to do what Applicants have done. A statement that modifications of the prior art to meet the claimed inventions would have “*well within the ordinary skill of the art* at the time the claimed invention was made” because the references teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); MPEP 2143.01.

Neither the PTO or the cited combination has reasonably explained how one of skill in the art would arrive at Applicants’ particular concentration of mica. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

The Undersigned must also ask for clarification as to the PTO’s comments as to ‘argument (C)’. Applicants’ invention of claims 1 and 18 is a particular paste having a particular composition that is not described in either reference. The Undersigned is confused as to how order of mixing is in any way relevant as to the invention of either Applicants’ claim 1 or claim 18. Sapper discloses a final aqueous coating composition. It never discloses the pigment paste of either of Applicants’ claims 1 or 18.

Accordingly, reconsideration and removal of the rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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